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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,430	07/29/2003	Yoshimi Mizuta	03500.017451.	5291
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FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER MORRISON, THOMAS A	
			ART UNIT	PAPER NUMBER
			3653	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/628,430

Applicant(s)

MIZUTA ET AL.

Examiner

Thomas A. Morrison

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and its dependent claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the structure or structural relationship that facilitates the recited "a sheet transported by a sheet transporting force of the image forming apparatus without a transporting drive force of said sheet treating apparatus". What structure allows this function to occur?

Claim 2 recites the limitation "the sheet transporting force" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 4, it is unclear how many different power supplies are claimed. Line 9 of claim 4 recites "a power supply". Then, line 11 of claim 4 recites "a power supply". It is unclear if the second recited power supply is the same or different from the previously recited power supply.

For claim 4, it is unclear what is meant by "said displacement body is displaced by a gravitational force of said displacement body is not urged upward by the position for guiding the sheet to said sheet stacking portion."

With regard to claim 5, this claim recites "a displacement body which can be displaced between a position for guiding the sheet to said sheet stacking portion and a position lower than the foregoing position for guiding the sheet to said sheet treating portion". This limitation appears to be inaccurate. Rather, Figs. 2 and 3 of the instant application appear to show that the position for guiding the sheet to the sheet treating portion is higher than the position for guiding the sheet to the sheet stacking position.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 and 6-7, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,685,180 (Saegusa et al.) in view of U.S. Patent No. 6,371,471 (Fukazu et al.).

Regarding claim 1, Figs. 2-6(c) of the Saegusa et al. patent show a sheet treating apparatus (Fig. 2) for subjecting a sheet transported from an image forming apparatus (including 11 and 17) to treatment, comprising:

a sheet stacking portion (including 18c and 18b) which is arranged to stack a sheet (S) transported by a sheet transporting force (i.e., the force of 17) of the image forming apparatus (including 11 and 17) without a transporting drive force of the sheet treating apparatus;

a sheet treating portion (including 26) which is arranged to subject the sheet transported from the image forming apparatus (including 11 and 17) to post-treatment;

a sheet guiding portion (19) which is arranged to selectively guide the sheet transported from the image forming apparatus (including 11 and 17) to one of the sheet stacking portion (including 18c and 18b) and the sheet treating portion (including 26);  
and

a sheet treatment control portion (column 6, lines 40-41) which controls the sheet treating apparatus (including 26);

wherein the sheet treatment control portion (column 6, lines 40-41) arranges the sheet guiding portion (19) to be in a position to guide the sheet to the sheet stacking portion (including 18c and 18b). Also, column 10, lines 25-65 of the Saegusa et al. patent explains that different modes can be selected for controlling the position of the sheet guiding portion (19) according to whether post-processing is performed or is not performed. Column 10, lines 52-65 disclose that sheet guiding portion 19 can initially be positioned in either the up or down position before one of the modes is selected. However, the Saegusa et al. patent does not specifically disclose that such sheet treatment control portion arranges the sheet guiding portion to be in a position to guide

the sheet to the sheet stacking portion in a state in which *a power supply of the sheet treating apparatus is turned off.*

The Fukazu et al. patent discloses a sheet treating apparatus (including 701, 550, 900, 400 and 800) with a controller (2000 in Fig. 4) that controls the sheet treating apparatus (including 701, 550, 900, 400 and 800) and arranges a sheet guiding portion (e.g., 551) to be in a position to guide a sheet to a sheet stacking portion (701) or a sheet treating portion (800). First, it is noted that when power is *not* supplied to a solenoid (2066 in Figs. 9A-9B), the sheet is guided along a path headed toward the stacking portion (701). Secondly, it is noted that lines 47-49 of column 9 specifically state that, "Since power is supplied to the unit corresponding to the function only when a function is needed, it can minimize power consumption during a waiting time." In other words, power is turned off to sheet treating devices not in use. It would have been obvious to one of ordinary skill in the art at the time the invention was made to operate the sheet treatment control portion of the Saegusa et al. patent in such a manner that it arranges the sheet guiding portion (19) to be in a position to guide the sheet to the sheet stacking portion (including 18c and 18b) in a state in which a power supply of the sheet treating apparatus (Fig. 2) is turned off, to minimize power consumption when no post-processing is performed, as taught by the Fukazu et al. patent.

Regarding claim 2, Fig. 2 of the Saegusa et al. patent shows that the sheet transporting force (via 17) is applied to the sheet at elevation above the sheet stacking portion (including 18c and 18b).

Regarding claim 3, Fig. 2 of the Saegusa et al. patent shows that the sheet treatment control portion (column 6, lines 40-41) arranges the sheet guiding portion (19) to be switched to a state of selecting the sheet stacking portion (including 18c and 18b) when the sheet is not transported for a predetermined period of time in the state in which it is selected to guide the sheet to the sheet treating portion (including 26). In particular, after the sheet is guided to the sheet treating portion (including 26), such sheet is no longer transported for a predetermined period of time during post-processing. After the predetermined time period, the sheet guiding portion (19) is flipped down to drop such sheet into the sheet stacking portion. This scenario meets the limitations of the claim.

Regarding claim 4, as best understood, Figs. 2-6(c) of the Saegusa et al. patent show that the sheet guiding portion comprises:

a displacement body (19) which can be displaced between a position for guiding the sheet to the sheet stacking portion (including 18c and 18b) and a position for guiding the sheet to the sheet treating portion (including 26); and

a drive portion (see M1 and column 10, lines 20-25) which displaces the displacement body (19) from the position for guiding the sheet to the sheet stacking portion (including 18c and 18b) to the position for guiding the sheet to the sheet treating portion (including 26), and

wherein when a power supply is activated the displacement body (19) is urged upward (Fig. 2) by the drive portion (see M1 and column 10, lines 20-25) to the position

Art Unit: 3653

for guiding the sheet to the sheet treating portion (including 26) and a power supply is turned off, the displacement body is displaced by a gravitational force of the displacement body (19) is not urged upward by the position for guiding the sheet to the sheet stacking portion (including 18c and 18b).

Regarding claim 6, Figs. 2-6(c) of the Saegusa et al. patent show that the displacement body (19) comprises a sheet guide path (upper surface of 19) which guides the sheet to the sheet treating portion (including 26).

Regarding claim 7, column 10, lines 17-21 of the Saegusa et al. patent disclose that the sheet treating portion (including 26) has one of a function for aligning sheets, a function for punching sheets, and a function for stapling sheets.

### ***Response to Arguments***

3. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

4. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. This claim also needs to be amended to address the rejections under 35 U.S.C. 112, second paragraph above.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

03/17/2006

  
**KATHY MATECKI**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**